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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,372	01/10/2002	Brian J. Mahoney	P05454US0	9324
34082	7590	08/05/2004	EXAMINER	
ZARLEY LAW FIRM P.L.C. CAPITAL SQUARE 400 LOCUST, SUITE 200 DES MOINES, IA 50309-2350			CHIN, GARY	
			ART UNIT	PAPER NUMBER
			3661	

DATE MAILED: 08/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/044,372

Applicant(s)

MAHONEY ET AL.

Examiner

Gary Chin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 15-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/12/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Newly submitted claims 15-20 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

(I) Claims 1-14 are drawn to a method of remote monitoring equipment for a machine in which the detected fault information of the machine is automatically transmitted to a person having owner, custodial or service responsibility for the machine.

(II) Claims 15-20 are drawn to a method of monitoring equipment for an agricultural machine by detecting the status of at least one operative part of the agricultural machine, determining a performance parameter from the detected status and subsequently transmitting a fault message to a remote location when the detected status and performance parameter fall outside the first and second predefined range respectively.

Groups (I) and (II) are two patentably distinct species of the claimed invention and there is no generic claim presented in the instant application.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 15-20 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Objections

2. Claims 3, 6-10 and 12-13 are objected to because of the following informalities:

As per claim 3, line 4, “fault information” should be “the fault information” in order to avoid the antecedent basis problem. Similarly, on lines 1-2 of both claims 6 and 7, “ the type of fault” should be “the fault information” respectively. On line 5 of both claims 7 and 9, “the

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agricultural implement” should be “an agricultural implement” respectively. Finally, on lines 1-2 of claim 13, “the detected fault message” should be “a detected fault message”.

As per claim 7, line 3 and claims 9, 10 and 12, all on line 2, the phrase “the operational parts” is unclear and should be changed to “the operational parts of the agricultural machine” respectively.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 5, lines 1-2, the clause “the machine is an agricultural machine” has been recited in the parent claim 1 and therefor is repetitive and should be deleted. Further, there is no clear recitation on lines 5-8 as to which claimed structural elements perform the “submitting” and “communicating” functions recited therein.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

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evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-6, 8-9 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (Patent application publication no. 2002/0016655 A1) in view of Scholl et al (patent no. 5400018).

As per claims 1-6 and 8-9, the reason for the rejection based upon the combined teachings of Joao and Scholl et al as set forth in the last office action is maintained and incorporated herein by reference.

As per claim 14, the claimed fleet manager is taught on page 10 of the Joao teaching.

7. Claims 7 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao and Scholl et al as applied to claims 1-6, 8-9 and 14, and further in view of Whitaker et al (patent no. 4296409).

As per claims 7 and 10-13, the reason for the rejection based upon the combined teachings of Joao, Scholl et al and Whitaker et al as set forth in the last office action is also maintained and incorporated herein by reference.

8. In the amendment, applicants essentially alleged that there is no motivation or suggestion found in the Joao or Scholl et al reference to derive the claimed feature of diagnosing the fault information at the machine instead of at the central information server as taught in Joao. Applicants' attention is directed to column 1, lines 24-32 of the Scholl et al reference in which it clearly stated that diagnosis of machine fault can take place either on-board the vehicle (or

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machine) or off-board the vehicle (such as a remote processing center) and such choice is merely dictated by the level or complexity of the diagnostics and/or the expertise of the operator. Hence, it is the examiner's contention that based upon the direct suggestion found in the Scholl et al teaching, one skilled in the art would have found it obvious to diagnose the fault information at the machine as claimed in the event that low level of fault diagnosis is deemed desirable. As to applicants' allegation that there is no suggestion in either Joao, or Scholl or Whitaker to substitute the diagnosis of crop processing fault information as shown in Whitaker with the operational fault information of Joao, such allegation is not found to be persuasive. The applied references are not limited to the preferred or exemplified embodiments disclosed therein to establish a prima facie case of obviousness, rather, they may be relied upon for all they would have reasonably conveyed to one having ordinary skill in the art. See In re Beattie, 974 F.2d 1309, 24 USPQ2d 1040 (Fed. Cir. 1992); In re Young, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991); Merck & Co., Inc. V. Biocraft Laboratories, Inc., 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir. 1989). It is the examiner's contention that since the Joao reference on page 9 discloses that the diagnosis fault information can be associated with any machines or vehicles and that the crop processing fault information associated with a combine is taught in figures 2-3 of the Whitaker et al reference, it would have been readily apparent for one skilled in the art, based upon the suggestion found in Joao, to incorporate such well known crop processing fault information associated with a combine as taught in Whitaker et al into the Joao system, in the event that the machine used in the Joao system is a combine as claimed.

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9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Chin whose telephone number is (703) 305-9751. The examiner can normally be reached on Monday-Friday 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas G Black can be reached on (703) 305-8233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



GARY CHIN
PRIMARY EXAMINER